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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,441	09/30/2003	Jorge Adams	03009-00	4133
8015	7590	06/19/2007	EXAMINER	
CYTEC INDUSTRIES INC. 1937 WEST MAIN STREET P.O. BOX 60 STAMFORD, CT 06904-0060			DRODGE, JOSEPH W	
			ART UNIT	PAPER NUMBER
			1723	
			MAIL DATE	DELIVERY MODE
			06/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/674,441	ADAMS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph W. Drodge	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Claims 26-28 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 and 21 of copending Application No. 10/892,847. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from claim 19 of '847 in either omitting the surfactant (claim 26) or including both an emulsifier and a surfactant, rather than merely a surfactant (claim 27). However the instant claims and claims of '847 commonly claim a composition with elements of oil-based mud, water-in-oil emulsion and polymer derived from water-soluble monomer.

Claim 3 remains provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/892,847, in view of claim 19 of '847. Claim 1 of '847 differs from instant claim 3 primarily in now also reciting the step of using a surfactant. However, claim 19 discloses oil-based mud contacting compositions as containing surfactant.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-28 remain rejected under 35 U.S.C. 102(b) as being anticipated by Dymond et al patent 4,777,200. Dymond et al '200 disclose compositions comprising oil-based drilling mud (column 2, lines 35-44 and column 5, lines 5-12), a water-in-oil emulsion, ***by definition comprising a continuous oil phase with discontinuous water phase, the water phase comprising polymer particles {viscosifying polymer particles} (column 4, lines 57-68), having an average particle size of less than 10 microns (column 4, lines 43-51). The viscosifying polymer particles may be derived or may include or have a coating formed, in-part, from water-soluble or hydrophilic monomers (column 6, lines 40-48 and column 7, lines 27-39).*** It is not germane for patentability whether or not the polymer particles are dissolved prior to contact to form a part of the oil-based drilling mud, since it is the final combination forming a final, mixed composition that is claimed.

Also disclosed are addition of emulsifiers, surfactant and water (column 3, lines 25-30 and lines 52-59) for claim 27; regarding claim 28, the composition is “well-dispersed” (column 4, lines 59-67 and column 9, lines 20-23).

Applicant's arguments filed on March 15, 2007, with respect to claims 26-28 have been fully considered but they are not persuasive.

It is argued that regarding claims 26-28, that the polymer particles which are less than 10 microns in size of Dymond are viscosifying particles which are not the same particles which are the "water-soluble particles". However, it is submitted that the claims are merely requiring that the polymer particles of less than 10 microns in size, are "derived" from water-soluble monomers, and not necessarily remaining water-soluble in final composition form when added to the oil-based drilling mud. The Dymond not only contains water-soluble polymer particles, it also contains viscosifying polymer particles that are composed of raw materials that are in-part water soluble monomers.

#### ALLOWABLE SUBJECT MATTER

Pending resolution of double patenting rejection, independent claim 1 remains distinguished by the recitation of "contacting...prior to contact with said oil-based mud ***[and]*** wherein the ***emulsion comprises polymer particles of*** average discrete phase particle size ***of [the polymer] less than about 10 microns...***" ***It is acknowledged that neither of the applied prior art references, Chen or Thompson, suggest such polymer particles applied to separate solids from liquid in an oil-based mud.***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Roy Sample, can be reached at 571-272-1376. The fax phone number for the examining group where this application is assigned is 571-273-8300.

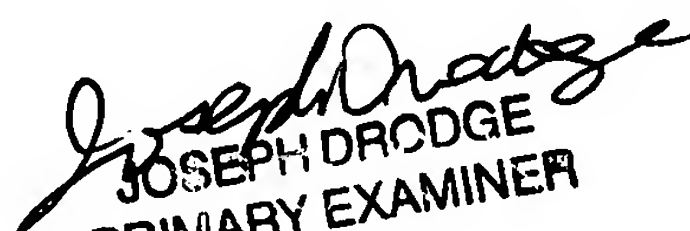
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more

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information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

June 11, 2007

  
JOSEPH DRODGE  
PRIMARY EXAMINER